

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Applicants: Bednorz et al.

Serial No.: 08/479,810

Filed: June 7, 1995

For: **NEW SUPERCONDUCTIVE COMPOUNDS HAVING HIGH TRANSITION
TEMPERATURE, AND METHODS FOR THEIR USE AND PREPARATION**

Date: July 29, 2003

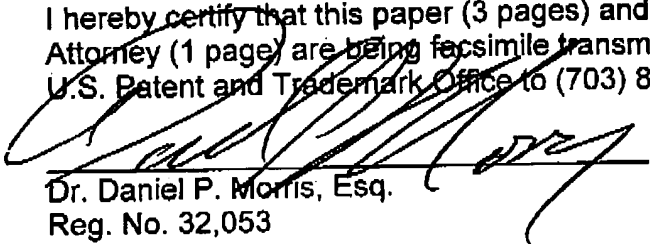
Group Art Unit: 1751

Examiner: M. Kopec

Docket No.: YO987-074BZ

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this paper (3 pages) and Appointment of Associate Power of Attorney (1 page) are being facsimile transmitted under Rule 37 CFR 1.61(d) to the U.S. Patent and Trademark Office to (703) 872-9600 on July 29, 2003.


Dr. Daniel P. Morris, Esq.
Reg. No. 32,053

REQUEST TO WITHDRAW SUSPENSION OF ACTION
IN RESPONSE TO APPLICANTS PETITION TO SUSPEND ACTION
UNDER 37 CFR 1.103 DATED 08/04/2000

On August 4, 2000 applicants petitioned for suspension of action in the above identified application until a decision was rendered by the Board of Patent Appeals and Interferences in an appeal in the copending divisional application 08/303,561 filed on August 9, 1994 (Divisional Application). The petition to suspend was granted in paper 29 dated October 6, 2000. Applicants requested the suspension since the issues presented in the appeal of the Divisional Application were essentially identical to the grounds for rejection in the present application. Applicants, therefore, felt that suspension of action in the present application was appropriate until there was a decision by the Board of Appeals and Interferences in the Divisional Application since suspension would potentially avoid unnecessary prosecution on the present application.

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Certain factual information (Additional Essential Information) that is primarily in the public domain that applicants believe is essential to their arguments in overcoming certain rejections of claims, which has been either entered in the present application or submitted with the response accompanying the Petition to Suspend Action, has not been entered in the Divisional Application. Some of this Additional Essential Information was obtained by applicants after the final rejection in the Divisional Application and some of this Additional Essential Information was obtained after the appeal brief was filed therein. Applicants submitted all of this Additional Essential Information in the Divisional Application by amendment after final rejection and with the appeal and reply briefs therein. Since applicants argument in the appeal and reply briefs of the Divisional Application relies on this Additional Essential Information and since the status of entry by the Examiner in the Divisional Application was unclear, the Board of Patent Appeals and Interferences remanded the Divisional Application back to the Examiner to clarify entry of this Additional Essential Information. Because this Additional Essential Information was submitted in the Divisional Application after final rejection, the examiner procedurally cannot enter this Additional Essential Information in the Divisional Application.

All of the Additional Essential Information submitted in the Divisional Application can be entered in the present application since it is not under final rejection. In fact, most of it has already been submitted. Therefore, applicants believe that it would not be an effective use of the USPTO's time, in particular the Examiner's time and the Board of the Appeals and Interferences' time to go forward with the appeal in the Divisional Application without all the addition Essential Information since the same issues will be before the examiner and possibly the Board again in the present application with all of the Additional Essential Information entered and considered. If the Divisional Application is not suspended, the Board of Appeals and Interferences could, in the absence of all the Additional Essential Information, render a decision inconsistent with the decision of the Examiner in the present application or by the Board in an appeal to the Board of Patent Appeals and Interferences in the present application which will have entered therein all of the Additional Essential Information.

Thus, concurrent herewith, applicants are submitting a Petition to Suspend Action Under 37 CFR 1.103 in the Divisional Application for the reasons given herein and applicants are requesting herein that the suspension of action in the present application be withdrawn. This will potentially avoid an unnecessary decision by the Board of Appeals and Interferences in the Divisional Application since all the issues may be resolved in the present application or the issues may be substantially simplified for appeal.

Suspension of action in the Divisional Application so that the prosecution of the present application can go forward with all of the Additional Essential Information considered and of record will either result in allowance of the claims herein or if applicants choose to appeal any unallowed claims that appeal will present to the Board of Patent Appeal and Interferences a complete factual record upon which to render a decision. Whereas if the Divisional Application is not suspended the Board will be presented for decision therein a record lacking very relevant factual information that is in the public domain.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted

By: 

Dr. Daniel P. Morris, Esq.

Reg. No. 32,053

Phone No.: (914) 945-3217

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598